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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/374,577      | 08/13/1999  | FORREST NABORS       | 34533-51            | 3935             |

7590

05/22/2002

ATTEN: GREGORY D. CALDWELL  
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EXAMINER

CHOULES, JACK M

ART UNIT

PAPER NUMBER

2177

DATE MAILED: 05/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/374,577

Applicant(s)

NABORS ET AL.

Examiner

Jack M Choules

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on through 5 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 1-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. Claims 1-56 were presented for examination. Of these, claims 1-47 are withdrawn as directed to a non-elected invention see below, thus claims 48-56 are treated on the merits.

#### *Election/Restriction*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-47, drawn to a system for transmitting, to select sellers, requests for quotes, receive answers thereto, sending acceptances to quotes, after configuring a desired product, classified in class 705 subclass 26.
- II. Claim 48-56, drawn to a vehicle description language created in a hierarchical data structure to store and transfer vehicle descriptions between computers via a computer network, classified in class 707, subclass 104.1. The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as it can be used for the exchange/sale of any type of product or service, not just for vehicles transactions. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Michael Proksch, Applicants' representative, (503-684-6200) on March 25, 2002, a provisional election was made without traverse to prosecute the invention of Group II, claims 48-56. Affirmation of this election must be made by

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applicant in replying to this Office action. Claims 1-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 48-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is apparently directed to a Data structure Per se as it is not clearly claimed as embodied in a computer readable media in the language of the claim “*for* storing a description of a vehicle in a first and a second computer memories and *for* transmitting” (emphasis added) recites an intended use rather than a positive recitation of the association of the description language or data structure with a storage media. See Warmerdam, 33 F.3d at 1360-1361 (claim to computer having specific memory held statutory, claim to data structure per se held non-statutory).

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 48-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons detailed in the following paragraphs.

10. Claim 48 and by dependence the others are directed to a vehicle description language, however, the body of the claim is related to a data structure it is not clear how these relate or what is meant by “the vehicle description language is created in a hierarchical data structure” to the understanding of the examiner a data structure is an organizational scheme which allows operations such as storage and retrieval of data in conjunction with a data storage, while a language is a particular syntax for describing instructions controlling the computer the language being “understood” and executed using a compiler or interpreter. A Data structure may contain or store commands, portions of a command, or data related to the commands but not create the language. For the purpose of this office action the claim is interpreted as being directed to a data structure.

11. The scope of the storage memories in “*for* storing a description of a vehicle in a first and a second computer memories” (emphasis added) is not clear. For the purpose of this office action the claim is interpreted as being directed to a data structure that has an intended use of being stored in memory rather than positively relating the data structure to the storage medium. The same problem of unclear scope is associated with the phrase “*for* transmitting”.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 48-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Draft Proposal [hereinafter the draft] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads" in view of Stupek, Jr. et al. [hereinafter Stupek] US Patent No. 6,131,118. (Note: the draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject matter of the claims is not found in that application.)

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15. As to claim 48, the draft disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (page 6-14); delimiters (page 6-14); and blocks sub-blocks and categories and data items (page 6-14).

16. The draft does not detail a public and private blocks. Stupek describes a system that includes public and private data blocks (col. 25, lines 1-35) showing the concepts of private and public data was known. Also no attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non- functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

17. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Stupek with the draft because the draft includes personal data (draft page 3) and it would have been obvious to protect this data from public distribution to protect the interests of the client in the system.

18. As to claims 49 and 50, the delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (page 6-14) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

19. As to claims 51-55 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

20. As to claim 56, the draft details XML (page 3).

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21. Claims 48-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozol et al. [hereinafter the Kozol] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads" in view of Stupek, Jr. et al. [hereinafter Stupek] US Patent No. 6,131,118. (Note: the draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject matter of the claims is not found in that application.)

22. As to claim 48, Kozol disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure 1); delimiters (figure 1); and blocks sub-blocks and categories and data items (figure 1).

23. Kozol does not detail a public and private blocks. Stupek describes a system that includes public and private data blocks (col. 25, lines 1-35) showing the concepts of private and public data was known. Also no attempt has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non-functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

24. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Stupek with Kozol because doing so would

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protect sensitive data from public distribution to protect the interests providing the data to the system.

25. As to claims 49 and 50, the delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (figure 1) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

26. As to claims 51-55 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

27. As to claim 56, Kozol details SGML (abstract) XML is a standard derived from SGML so it would be obvious to also use the features of the Kozol invention with XML, as it would extend to the functionality to the new standard.

### ***Drawings***

28. New formal drawings are required in this application because the draftsman objected to the drawings see PTO 948. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

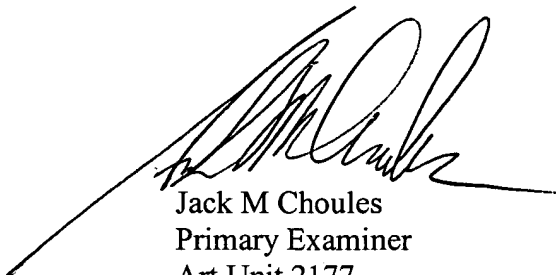
- |    |              |           |                               |
|----|--------------|-----------|-------------------------------|
| a. | Hesse et al. | 5,185,698 | Similar to Kozol.             |
| b. | Call         | 6,154,738 | Data format compliant to XML. |

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30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (703) 305-9840. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-8449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Jack M Choules  
Primary Examiner  
Art Unit 2177

jmc  
May 20, 2002